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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/576,730 | 05/23/2000 | David Creemer | PAILM-2976.US.P | 4739 |

7590 11/12/2003

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| EXAMINER |
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WANG, LIANG CHE A

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| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,730

Applicant(s)

CREEMER, DAVID

Examiner

Liang-che Alex Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 5-21 have been examined
2. The text of those sections of Title 35, US Code not included in this section can be found in a prior Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Abdous et al, US Patent Number 5,577,210, herein after Abdous. Abdous has taught a data processing system comprising:

a bootstrap server (item 1 figure 1 and Col 2 lines 3-4) having an extended set of communication functions stored thereon (Col 2 lines 9-15) and a core set of communication functions (core set of communication function is inherent in order for the bootstrap server to function) for emulating communication between a personal digital assistant and a desktop computer system (bootstrap server is viewed as a desktop computer system);

a personal digital assistant (Item 21 figure 1, Col 2 lines 3-4, at least one terminal, this electronic terminal which is a digital device that help a person to organized or computing data could be named a personal digital assistant.) having a core set of communication function in non-volatile memory thereon (this is a inherent feature, a

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digital terminal required software in the non-volatile in order to communicate with the server, without this core set of communication function. The terminal is only a non operational object,) said core set of communication function operable to allow said personal digital assistant to communicate with a desktop computer system (Col 2 lines 4-5, the terminal is remotely booted by the server.)

wherein said bootstrap server is able to transfer said extended set of communication functions to said personal digital assistant by said bootstrap server and said personal digital assistant using said core set of communication functions (Col 2 lines 3-14, Abdous taught a method for remote booting by a server of at least one terminal. In order for a server to remotely boots a terminal, said terminal must already contains a set of code for initially connected with the server (this is viewed as a core set of communication functions), and the code updated received by the terminal is viewed as the extended set of communication functions)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 5-16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over in combination of Abdous et al, US Patent Number 5,577,210, herein after Abdous,

Boothby, US Patent Number 6,405,218, and Schwitters et al. US Patent Number 6,526,413, Hereinafter Schwitters.

7. Referring to claim 5, Abdous has taught a method of restoring basic functionality to a device (see title) comprising the steps of:
 - a. making a connection between a bootstrap server and a portable computer system (item 1, figure 1, and Col 2 lines 3-4) and a terminal computer system (item 21);
 - b. synchronizing said bootstrap server with said terminal computer (Col 2 lines 9-11, when the data in the server side is being recopied into an image file and send to a terminal is considered as synchronizing), wherein said server uses synchronization software which is compatible with a core set of communication functions stored in said portable computer's non-volatile memory (this is a inherent feature, a digital terminal required software in the non-volatile in order to communicate with the server, without this core set of communication function. The terminal is only a non operational object;) that is adapted to synchronize said terminal computer system to a desktop computer system (Col 2 lines 3-15, server 1 is viewed as the desktop computer system);
 - c. transferring first software from said bootstrap server to a volatile memory unit of said terminal computer system (Col 2 lines 3-14, Abdous taught a method for remote booting by a server of at least one terminal. In order for a server to remotely boots a terminal, a set of code is being transferred from the bootstrap server to the volatile memory unit of said terminal computer system, support can also be found in the previous actions);

Abdous has not taught an enterprise server operable to connect to said terminal computer system, wherein said terminal computer system and said enterprise server communicate and transfer information with said terminal computer system using said extended set of communication.

However, Schwitters has taught enterprise server (item 24 figure 1) operable to connect to a personal digital assistant (item 22 figure 1), wherein said personal digital assistant and said enterprise server communicate and transfer information with said personal digital assistant using a extended set of communication (a software is required for server and PDA to communicate.).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's terminal computer system to be a portable computer system which is able connected to a enterprise server, which is operable to connect to Abdous's terminal, wherein said terminal and said enterprise server communicate and transfer information with said terminal using a extended set of communication as described by Schwitters,

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because PDA requires a set of communication functions in order to communicate with the enterprise server, and the bootstrap server of Abdous is transferring data to the PDA, a person with ordinary skill in the art would realized that the required data to communicate between PDA and enterprise server could also be saved in the bootstrap server to backup the data or software required to communicate between PDA and enterprise server.

8. Referring to claim 6, Abdous has further taught wherein step c) comprises the step of:
c1) transferring an extended set of communication functions from said bootstrap server to said portable computer system (Col 2 lines 3-14, Abdous taught a method for remote booting by a server of at least one terminal, the process of booting is transferring a extended set of communication functions.)
9. Referring to claim 7, Abdous has further taught wherein said bootstrap server and said portable computer system are operable to communicate via a Ethernet connection (Col 3 lines 54-56)

Abdous has not taught the communication via a telephone line. However, Boothby has taught the communication between the server and portable computer system could be connected via a telephone lines.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's bootstrap server and terminal to communicate via a telephone line.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because bootstrap server and the terminal of Abdous requires a connection means for communication and Boothby provides a variety of connection means for server and remote computers to connects. It would be obvious for Abdous to use Boothby's connection means including telephone lines to adapt more communication methods.

10. Referring to claim 8, Abdous combined with Schwitters has taught an invention as described in claim 5. Abdous combined with Schwitters has not taught wherein said data

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was backed up on said enterprise server from a pervious synchronization between said enterprise server and said portable computer system.

However, Boothby has taught synchronizing the records of the local and remote databases by using a history file ... which records have been changed, since the previous synchronized and which records of the two databases correspond to one another (Col 5 lines 43-51).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Schwitters's data backed up on its server from a pervious synchronization between said server and said portable computer system.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous and Schwitters because having the memory in both portal computer and the enterprise server synchronized would allow two systems to be more compatible to each other (Col 1 lines 40-54).

11. Referring to claim 9, Abdous has further taught wherein said portable computer system is a personal digital assistant (Item 21 figure 1, Col 2 lines 3-4, at least one terminal, this electronic terminal which is a digital device that help a person to organized or computing data could be named a personal digital assistant.)
12. Referring to claim 10, Abdous combined with Schwitters has taught an invention as described in claim 5, Schwitters has further taught wherein said personal digital assistant communicates with said enterprise server over the Internet (see Figure 1 item 24);

13. Referring to claims 11-16, claims 11-16 encompass the same scope of the invention as that of the claims 5-10. Therefore, claims 11-16 are rejected for the same reason as the claims 5-10.

14. Referring to claim 17, Abdous has taught a data processing system comprising:

a bootstrap server (item 1 figure 1 and Col 2 lines 3-4) having an extended set of communication functions stored thereon (Col 2 lines 9-15) and a core set of communication functions (core set of communication function is inherent in order for the bootstrap server to function) for emulating communication between a personal digital assistant and a desktop computer system (bootstrap server is viewed as a desktop computer system);

a personal digital assistant (Item 21 figure 1, Col 2 lines 3-4, at least one terminal, this electronic terminal which is a digital device that help a person to organized or computing data could be named a personal digital assistant.) having a core set of communication function in non-volatile memory thereon (this is a inherent feature, a digital terminal required software in the non-volatile in order to communicate with the server, without this core set of communication function. The terminal is only a non operational object,) said core set of communication function operable to allow said personal digital assistant to communicate with a desktop computer system (Col 2 lines 4-5, the terminal is remotely booted by the server.)

wherein said bootstrap server is able to transfer said extended set of communication functions to said personal digital assistant by said bootstrap server and said personal digital assistant using said core set of communication functions (Col 2 lines

3-14, Abdous taught a method for remote booting by a server of at least one terminal. In order for a server to remotely boots a terminal, said terminal must already contains a set of code for initially connected with the server (this is viewed as a core set of communication functions), and the code updated received by the terminal is viewed as the extended set of communication functions)

15. Referring to claim 18, Abdous has taught an invention as described in claim 17. Abdous has not taught an enterprise server operable to connect to said personal digital assistant, wherein said personal digital assistant and said enterprise server communicate and transfer information with said personal digital assistant using said extended set of communication.

However, Schwitters has taught enterprise server (item 24 figure 1) operable to connect to said personal digital assistant (item 22 figure 1), wherein said personal digital assistant and said enterprise server communicate and transfer information with said personal digital assistant using a extended set of communication (a software is required for server and PDA to communicate.).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's terminal (PDA) to be able connected to a enterprise server, which is operable to connect to Abdous's terminal, wherein said terminal and said enterprise server communicate and transfer information with said terminal using a extended set of communication as described by Schwitters,

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because PDA requires a set of communication functions in order

to communicate with the enterprise server, and the bootstrap server of Abdous is transferring data to the PDA, a person with ordinary skill in the art would realized that the required data to communicate between PDA and enterprise server could also be saved in the bootstrap server to backup the data or software required to communicate between PDA and enterprise server.

16. Referring to claim 19, Abdous has further taught wherein said bootstrap server and said personal digital assistant are operable to communicate via a Ethernet connection (Col 3 lines 54-56)

Abdous has not taught the communication via a telephone line. However, Boothby has taught the communication between the server and personal digital assistant could be connected via a telephone lines.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's bootstrap server and terminal to communicate via a telephone line.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because bootstrap server and the terminal of Abdous requires a connection means for communication and Boothby provides a variety of connection means for server and remote computers to connects. It would be obvious for Abdous to use Boothby's connection means including telephone lines to adapt more communication methods.

17. Referring to claim 20, Abdous combined with Schwitters has taught an invention as described in claim 17, Schwitters has further taught wherein said personal digital

assistant communicates with said enterprise server over the Internet (see Figure 1 item 24);

18. Referring to claim 21, Abdous has further taught wherein said core set of communication functions is synchronization logic (Col 2 lines 9-11, when the data in the server side is being recopied into an image file and send to a terminal is considered as synchronizing.)

Response to Arguments

19. Applicant's arguments filed 09/30/2003, paper number 9, have been fully considered but they are not persuasive.
20. In that remarks, applicant's argues in substance:

- a. That: "Abdous fails to teach or suggest that the code in the terminal is "adapted to synchronize a portable computer system to a desktop computer system" as claimed." (Page 7).

This is found not persuasive because Abdous as modified with Schwitters does teach or suggest the limitation of "adapted to synchronize a portable computer system to a desktop computer system" as indicted in the rejection to claim 5. There is no doubt that there must be codes exist for Abdous's server to communicate with Abdous's terminal computer system (computers devices required codes to operate), and Abdous has taught the synchronization between the server and the terminal computer system (Col 2 lines 9-15), and a person with ordinary skill in the art knows that a server is obviously a desktop computer system, and a terminal computer system that communicates with a server could be

a portable computer system. Therefore, applicant's argument is not persuasive because Abdous as modified has taught the limitation "adapted to synchronize a portable computer system to a desktop computer system."

- b. That: "Abdous fails to teach or suggest "the bootstrap server appears to said portable computer system as a desktop computer system."" (Page 8)

This is not found persuasive because as discussed above, a person with ordinary skill in the art knows that a server is obviously a desktop computer system. The definition of "desktop" according to Microsoft Computer Dictionary, fourth edition, "**desktop** is an on-screen work area that uses icons and menus to simulate the top of a desk. a desktop is characteristic of the Apple Macintosh and of windowing programs such as Microsoft Windows..." and Server is known as a computer system that provides a service to other terminals. Therefore, applicant's argument is not persuasive because a server is a computer, which can also be viewed as a desktop computer system.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

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22. Hawkins et al., US Patent Number 6,006,274, has taught a method and an apparatus using a pass through personal computer connected to both a local communication link and a computer network for identifying and synchronizing a preferred computer with a portable computer.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-8159. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications.
25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Liang-che Alex Wang *lcw*
November 5th, 2003


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER